

## REMARKS

Claims 11-32 remain in the present application. Claims 11, 16-18, 22 and 29 are amended herein. Applicants respectfully submit that no new matter has been added as a result of the Claim amendments. Applicants respectfully request further examination and reconsideration of the rejections based on the amendments and arguments set forth below.

### Claim Rejections – 35 U.S.C. §103

Claims 11-32 are rejected in the present Office Action under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication Number 2004/0048503 by Mills et al. (hereafter referred to as “Mills”) in view of United States Patent Number 6,691,149 to Yokota et al. (hereafter referred to as “Yokota”). Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 11-32 are not rendered obvious by Mills in view of Yokota for the following reasons.

Applicants respectfully direct the Examiner to independent Claim 1 that recites a method for copying an application on a portable computer having a main memory and a removable memory, comprising (emphasis added):

updating a displayable category list to comprise a name of a category associated with said removable memory;  
choosing an application of said main memory to copy;  
changing a category name of said application from a category associated with said main memory to said category associated with said removable memory; and  
in response thereto, automatically copying said application to said removable memory.

Claims 12-16 depend from independent Claim 11 and recite further limitations to the claimed invention. Claims 18-21 depend from independent Claim 17 and recite further limitations to the claimed invention. Claims 23-28 depend from independent Claim 22 and recite further limitations to the claimed invention.

Claims 30-32 depend from independent Claim 29 and recite further limitations to the claimed invention.

Applicants respectfully assert that Mills fails to teach or suggest the limitations of “updating a displayable category list to comprise a name of a category associated with said removable memory” as recited in independent Claim 11. As recited in the present application, a category list may be updated to comprise the name of a category associated with a removable memory. Additionally, the category list may be displayed on a portable computer.

In contrast to the claimed embodiments, Applicants understand the cited portions of Mills to teach that an expansion card may be coupled to a PDA (paragraph 35), where the PDA may include a display screen (paragraph 147). However, Applicants find no teaching or suggestion in Mills of the updating of a displayable category list to comprise the name of a category associated with a removable memory as claimed.

Furthermore, the rejection states on page 4 in the “Response to Arguments” section that “Miller’s [sic] teachings of removable memory which implies that some type of an identifier...” Assuming *arguendo* that an identifier is analogous to a category as claimed, Applicants respectfully disagree with the rejection’s statement that a teaching of a removable memory implies a category or category list as claimed. Applicants respectfully remind the Examiner that in order to establish inherency, extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The

mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). As such, Applicants respectfully invite the Examiner to introduce extrinsic evidence to establish the alleged inherency or to kindly withdraw the rejections.

Moreover, even assuming *arguendo* that a category is inherent in a teaching of a removable memory, Applicants respectfully assert that updating a displayable category list as claimed is neither expressly or inherently taught or suggested by Mills. Furthermore, Mills also fails to teach or suggest, either expressly or inherently, that such a displayable category list is updated to comprise a name of a category associated with a removable memory as claimed.

Applicants respectfully assert that that Yokota, either alone or in combination with Mills, fails to cure the deficiencies of Mills discussed above with respect to independent Claim 11. Specifically, Applicants respectfully assert that Yokota also fails to teach or suggest the limitations of “updating a displayable category list to comprise a name of a category associated with said removable memory” as recited in independent Claim 11.

Regarding the limitations of “changing a category name of said application from a category associated with said main memory to said category associated with said removable memory” as recited in independent Claim 11, Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness as the rejection does not address these claim limitations. Specifically, as noted in MPEP §706.02(j), “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Section

706.02(j) of the MPEP also states that “the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate” and “(B) the difference or differences in the claim over the applied reference(s).” As such, Applicants respectfully request that the Examiner either supplement the existing rejection to comply with 35 U.S.C. §103 and the MPEP, or kindly withdraw the rejection.

Assuming arguendo that a prima facie case of obviousness has been shown, Applicants respectfully assert that Mills fails to teach or suggest the limitations of “changing a category name of said application from a category associated with said main memory to said category associated with said removable memory” as recited in independent Claim 11. As recited in the present application, an application may be copied in part by changing a category name of the application from a category associated with a main memory to a category associated with a removable memory.

In contrast to the claimed embodiments, Applicants understand Mills to teach that an expansion card may be coupled to a PDA (paragraph 35) as discussed above. However, Applicants find no teaching or suggestion of a category name of an application. Moreover, Applicants find no teaching or suggestion of a changing of a category name from that of a category associated with a main memory to that of a category associated with a removable memory.

Applicants respectfully assert that that Yokota, either alone or in combination with Mills, fails to cure the deficiencies of Mills discussed above with respect to independent Claim 11. Specifically, Applicants respectfully assert that

Yokota also fails to teach or suggest the limitations of “changing a category name of said application from a category associated with said main memory to said category associated with said removable memory” as recited in independent Claim 11. For example, Applicants respectfully assert that Yokota fails to teach or suggest a category or category name as claimed, and further assert that Yokota fails to teach or suggest changing a category name as claimed. Nonetheless, even assuming arguendo that file information taught by Yokota is analogous to a category or category name as claimed, Yokota explicitly teaches that a host and a memory card use the same file structure as shown in Figures 7 and 25 of Yokota (col. 37, lines 13-15). As such, assuming arguendo that the file hierarchy and directory information as shown by Figures 7 and 25 of Yokota are analogous to categories and category names as claimed, Yokota explicitly teaches away from the claimed embodiments by teaching that category information is not changed (e.g., the “same file structure”) during a file transfer from a host to a memory card instead of changing a category name to effectuate the copying of a file as claimed.

For these reasons, Applicants respectfully assert that independent Claim 11 is not rendered obvious by Mills in view of Yokota, thereby overcoming the 35 U.S.C. §103(a) rejection of record. Since independent Claims 17, 22 and 29 contain limitations similar to those discussed above with respect to independent Claim 11, independent Claims 17, 22 and 29 also overcome the 35 U.S.C. §103(a) rejections of record. Since Claims 12-16, 18-21, 23-28 and 30-32 depend from and recite further limitations to the invention claimed in their respective independent Claims, Claims 12-16, 18-21, 23-28 and 30-32 also overcome the 35 U.S.C. §103(a) rejections of record. Thus, Claims 11-32 are therefore allowable.

CONCLUSION

Applicants respectfully submit that Claims 11-32 are in condition for allowance and Applicants earnestly solicit such action from the Examiner.

The Examiner is urged to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Respectfully submitted,

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